



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Application No. 10/753,270

Applicant: FEYGENSON, Anatoly

Filed: January 8, 2004

TC/AU: 3629

Examiner: CASLER, Traci

Docket No.: 225265

Customer No.: 23460

APPELLANTS' APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
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Dear Sir:

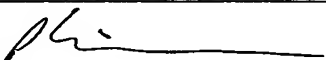
In support of the appeal from the final rejection dated May 12, 2009,
Appellants now submit their Brief.

Real Party In Interest

The patent application that is the subject of this appeal is assigned to American
International Group, Inc.

Related Appeals and Interferences

There are no appeals or interferences that are related to this appeal.

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Status of Claims

Claims 1-15 and 20 have been withdrawn. Claims 16-32 have been rejected under 35 USC section 101. Claims 21-32 have been rejected under 35 USC section 112. Claims 16-18 have been rejected under 35 USC section 102. Claims 19 and 21-32 were rejected under 35 USC section 103. All pending claims 16-19 and 21-32 are herewith appealed.

Status of Amendments

There are no pending or unentered amendments.

Summary of Claimed Subject Matter

The invention of claim 16 pertains to a method for accessing, engaging and managing human resources to perform a task. Initially, a task is broken down into different types atomic units of work needed to perform the task [0046], [0048]. A notification is then electronically provided to a pool of potential applicants of the need to produce at least one of the types of atomic unit of work [0051]. The work, once performed, is capable of being transmitted electronically over the Internet to an employer computer system. *See* FIG. 5. The notified pool of workers includes at least one applicant who is qualified to perform the relevant type of atomic unit of work. [0026]

At least one candidate is selected from within the pool to perform the at least one type of atomic unit of work [0052-0053], after which payment is negotiated for each atomic unit of work the selected candidate [0047], after which each selected candidate is compensated the negotiated amount for each atomic unit of work performed. [0059]

The invention of claim 18 is dependent upon claim 16 and further requires the step of determining the pool of potential candidates via an indirect message delivery process. *See* [0015]: "All communications between an EWP participant and employer may be handled via the Administrative System, as opposed to direct communications with the participant. This indirect communication channel facilitates privacy protection and dispute resolution"

Claim 19 pertains to a method for performing a task. The method involves first separating the task into subparts, so that certain of the subparts can be performed as atomic units by members of a pool of potential workers. The method then entails determining the type of atomic units of work needed to perform the subparts of the task that are performable on an atomic unit basis. At least one candidate is selected to perform each type of atomic unit of work. The work product is received over the Internet at an employer computer system, at which time the selected candidates are compensated for each received atomic unit of work.

Claim 21 pertains to a method for utilizing the skills of independent contractors. The skills of the contractors have been input as searchable data in an electronic database [0043] and the method involves first searching the database [0049] to identify a group of individual independent contractors whose skills match criteria for a type of atomic unit of work [0046], [0048]. The method next entails offering to the individual independent contractors in the identified group an opportunity to perform the type of atomic units of work [0051]. At least one individual independent contractor is selected from the group to perform the type of atomic units of work, and is provided uncompleted atomic units of work [0053]. The method next entails receiving the work product for each completed atomic unit of work from the selected individual independent contractor over the Internet at an employer computer system [0059]. The selected individual independent contractor is paid for each completed atomic unit of work *Id.*

Grounds of Rejection to be reviewed on Appeal

The grounds of rejection to be reviewed on appeal are: The rejection of claims 16-32 under 35 USC section 101. The rejection of claims 21-32 under 35 USC section 112. The rejection of claims 16-18 under 35 USC section 102. The rejection of claims 19 and 21-32 under 35 USC section 103.

Argument

The Rejection of Claims 16-32 Under 35 USC Section 101

The Action states that claims 16-32 “are rejected under 35 U.S.C. §101 because the claims do not limit any process step to any specific machine/apparatus or transformation of an article.” Claim 16 requires “electronically providing to a pool of potential applicants a

notification of a need to produce at least one type of atomic unit of work, wherein the work is capable of being transmitted electronically over the Internet to an employer computer system.” Further, claim 19 requires *inter alia*, “receiving the work product for each performed atomic unit of work over the Internet at an employer computer system.” In addition, claim 21 requires *inter alia*, “receiving the work product for each completed atomic unit of work from the selected individual independent contractor over the Internet at an employer computer system.” Thus, each of the claims is tied to a particular machine, namely a computer system that receives/transmits work product or an atomic unit of work.

Further, receiving or transmitting work electronically over the Internet to a computer system is not insignificant extra solution activity, but rather an important aspect of the invention. **Indeed, the system is not capable of functioning without this feature.** The pending application describes this significant aspect of the invention throughout the specification. Generally, the claimed invention includes methods that relate to a nonconventional employment model called an Extended Work Program (EWP). (¶¶ [0001]-[0002]). EWP uses the Internet to identify, employ, manage, and compensate workers in a distributed computer environment (*Id.*; FIG. 1). Further, EWP allows workers the freedom to choose their work locations. (¶¶ [0002]-[0003]). Hence, an employer and a worker are residing in geographically dispersed locations. This allows the employer to select from a large pool of workers with different levels of professional experience and assign work that matches a worker’s experience level. Otherwise, if an employer is limited to hire from a pool of local workers, the employer may not be able to find a suitable candidate for a specific task.

FIG. 1 and its associated description discuss aspects of the invention that facilitate communication between an employer computer system and a worker computer system, across the Internet, wherein each computer system resides in a different location. (¶¶ [0024]-[0027]). This feature of the invention allows an employer to assign tasks to a worker and a worker to deliver the subsequent completed tasks. Otherwise, the employer would not be able to hire a worker residing in a geographically dispersed location and would limit the size of the pool of workers available to the employer. Assigning and completing work as well as selecting a worker with suitable experience for a particular task are significant aspects of the invention.

Thus, the claims are tied to a particular machine, namely to a computer system that has to perform very specific functions. Moreover, for the reasons set forth above, the

involvement of a computer system in the claimed methods is a critical aspect of the invention. Therefore, the amended independent claims 16, 19, and 21 claim patentable subject matter under 35 U.S.C. § 101 and thus Applicants respectfully request favorable reconsideration of the rejections under § 101.

Further, with respect to claims 17, 18, 22-32, all of which depend directly or indirectly from one of claims 16 and 21, it is respectfully submitted that such dependent claims are statutory and patentable for at least the same reasons as claims 16 and 21 respectively.

The Rejection of Claims 21-32 Under 35 USC Section 112

The Action alleges, as the basis for this set of rejections, that “Applicant fails to disclose an independent contractor as a candidate. This is plainly not true. Applicants previously identified by page and paragraph the specification’s description of how participants in the Employee Work Program (“EWP”) choose their own hours, locations, types of work and even employers. (First Appeal Br. at 5.) By definition, such participants would indeed be considered independent contractors. (*Id.*) Moreover, the specification describes a new employment system and method to address the problem of unemployed and underemployed workers. It should be readily apparent to those of skill in the art that the participants are not conventional employees.

Importantly, the Answer concedes that the term “independent contractor” has a known meaning. (Answer, p. 7-8.) It also concedes that the specification describes EWP participants as meeting the requirements for appropriate characterization as “independent contractors.” (*Id.*, p. 8.) These concessions should establish beyond dispute that the specification adequately describes a method involving independent contractors.

The Federal Circuit places the burden on the *Examiner* to establish the lack of written description. *See In re Alton*, 76 F.3d 1168, 37 U.S.P.Q.2d 1578, 1583-4 (Fed. Cir. 1996). Where, as here, “the specification contains a description of the claimed invention, albeit not *in ipsius verbis* (in the identical words), **then the examiner or Board...** must provide reasons why one of ordinary skill in the art would not consider the description sufficient.” *Id.*

(emphasis added). In the present case, the Examiner has not offered any evidence or reasoning to meet the Office's burden.

The appropriate test is whether the Applicants' specification demonstrated possession of the invention as involving independent contractors as participants, and the answer is clearly yes, one of skill in the art, and indeed most without skill in the art, would recognize the EWP participants as independent contractors. Under the correct legal analysis, the rejection of claims 21-32 for lack of written description under 35 U.S.C. § 112 should be reconsidered and withdrawn.

The Rejection of Claims 16-18 Under 35 USC Section 102

The Action argues that rejected claims 16-18 are anticipated by Bukow. Bukow, however, manifestly does not describe the step of "determining several types of atomic units of work needed to perform a task."

The Examiner speculates that Bukow's website artwork may be an atomic unit of work that is part of a larger task. Even if this argument is credited, Bukow does not describe the step of determining *several* types of atomic units. Bukow is simply silent on the point. Bukow further fails to describe at all the concept of "several types" of atomic units of work needed to perform a task. As noted in Applicants' Appeal Brief, even if the "artwork" could be considered an atomic unit of work, Bukow does not describe the step of determining different "types" of atomic units of work needed to perform a task.

The prior Answer attempts to sidestep this problem by arguing that "the proceeding steps simply require 'at least one' type of atomic unit to be performed." (Answer, p. 9.) Although this is correct, claim 16 nevertheless still requires the step of determining *several* types of atomic works. *One* is not *several*. Because Bukow does not describe this step, expressly or inherently, it cannot possibly anticipate claim 16.

Claim 18 requires "an indirect message delivery process," which means they avoid direct communications with the participant. This indirect communication channel facilitates privacy protection and dispute resolution, as noted in the summary above. Bukow arguably

discloses a *direct* message process, which the Examiner notes at page 9 of the prior Answer, but Bukow does not disclose the claimed *indirect* process.

For the foregoing reasons, Bukow does not describe the subject matter of claims 16-18. The Answer's rejection of these claims as being anticipated by Bukow should be reconsidered and withdrawn.

The Rejection of Claims 19 and 21-32 Under 35 USC Section 103

The Action gives no logically sound reason to combine Bukow and Medquist. Indeed, one of the allegedly supporting statements seems to point the other way. *See* Action at paragraph 13: "If payments are being made for work done the work will *cease* to be complete." Clarification is needed here, as this makes no sense at all. Why would work *cease* to be complete if payment is made?

Moreover, as previously noted, Bukow does not describe the actual claim limitations. This reference does not disclose the steps of "separating the task into subparts, wherein certain of the subparts may be performed on an atomic unit basis by a pool of potential workers" and then "determining the type of atomic units of work needed to perform the subparts" (Claim 19) and "offering to the individual independent contractors in the identified group an opportunity to perform the type of atomic units of work" (Claim 21). Even if the Examiner's argument regarding Bukow's description of website artwork is credited, Bukow manifestly does not describe the step of determining *several* types of atomic units.

In addition, neither Bukow nor Medquist describes the step in claim 21 of "receiving the work product for each completed atomic unit of work from the selected individual independent contractor over the Internet." The Examiner *concedes* that Bukow does not describe this limitation, but then cites to a section of Medquist (p. 18, ¶ B) that describes a *client's* use of the Internet. This portion of Medquist does not describe in any way the activities of the person who actually performed the work. As such, the Examiner has failed to establish a *prima facie* case of obviousness even if the hypothetical combination of Bukow/Medquist had been proper.

In addition, the hypothetical combination of Bukow/Medquist simply does not teach the steps set forth in claims 22-32. Among other things, Medquist describes a medical

coding operation; it does not describe a work process for reviewing a document for typographical errors (claim 22) or transcription (claim 23) for a certain duration (claim 24). It also does not describe a work process for insurance claims (claims 25, 26) or processing accounts payable (claim 27). Likewise, neither Bukow nor Medquist addresses the qualifications of participants as measured by English language skills (claim 28), a high school diploma (claim 29), or completion of a specialized training program tailored to the specific atomic unit of work (claim 30). Finally, there is nothing in either reference that screens candidates based on prior experience in conducting the particular type of atomic units of work (claims 31, 32). The rejections involving these claims should be reconsidered and withdrawn due to the absence of a *prima facie* case of obviousness.

Respectfully submitted,



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Claims Appendix

1. (Withdrawn) A method for efficiently accessing, engaging and managing human resources, the method comprising the steps of:

- identifying a task that must be performed;
- dividing the task into types of atomic unit of work that can be performed by persons with specialized training;
- determining a payment for each atomic unit of work of the identified type;
- identifying candidates capable of performing the type of atomic unit of work by consulting a knowledge-base, which includes data that (a) uniquely identifies each candidate, (b) indicates the qualifications of each candidate, (c) indicates an assessment of each candidate's ability to perform the type of atomic unit of work relative to other candidates' ability to perform the same type of atomic unit of work; and (d) indicates the quality of actual performance of atomic units of work if the candidate has previously performed such atomic units of work;
- selecting at least one of the identified candidates to perform atomic units of work of the identified type;
- paying the selected candidate the determined payment for each performed atomic unit of work of the identified type.

2. (Withdrawn) The method of claim 1 further comprising the step of determining an assessment of the quality of performance of the atomic units of work by the selected candidate.

3. (Withdrawn) The method of claim 2, wherein the step of determining an assessment includes the step of comparing the performance of the atomic units of work by the selected candidate against an objective criterion.

4. (Withdrawn) The method of claim 3, wherein the step of comparing includes comparing the timeliness of the performance of the atomic units of work by the selected candidate against predetermined deadlines for performance.

5. (Withdrawn) The method of claim 3 further comprising the step of adding data to the knowledge-base that is indicative of the determined assessment of the performance of the selected candidate.

6. (Withdrawn) The method of claim 1, wherein the step of paying is conducted before learning the personal identity of the selected candidate.

7. (Withdrawn) The method of claim 1, wherein the payment to the selected candidate is free of employment taxes.

8. (Withdrawn) The method of claim 1 further comprising the step of authenticating that the selected candidate is actually the person uniquely identified by data in the knowledge-base.

9. (Withdrawn) The method of claim 1 further comprising the step of receiving results of each atomic unit of work from the selected candidate via the Internet.

10. (Withdrawn) The method of claim 1 further comprising the step of receiving results of each atomic unit of work from the selected candidate via a human-centric trusted computing environment that uses the Internet as the transmission medium.

11. (Withdrawn) The method of claim 10 further comprising the step of continuously verifying with biometric data that each transmission via the trusted computing environment was actually made by the selected candidate.

12. (Withdrawn) The method of claim 11 further comprising the step of correlating different biometric data with an established ability to perform at least one type of atomic unit of work.

13. (Withdrawn) The method of claim 1 further comprising the step of training the selected candidate to perform at least one type of atomic unit of work.

14. (Withdrawn) The method of claim 13 further comprising the step of testing the selected candidate to determine whether the selected candidate can perform the at least one type of atomic unit of work.

15. (Withdrawn) The method of claim 1 further comprising the step of re-identifying a type of atomic unit of work that can be performed by persons with specialized training to meet an objective criterion

16. (Previously Presented) A method for efficiently accessing, engaging and managing human resources to perform a task, the method comprising the steps of:

- determining several types of atomic units of work needed to perform a task;
- electronically providing to a pool of potential applicants a notification of a need to produce at least one type of atomic unit of work, wherein the work is capable of being transmitted electronically over the Internet to an employer computer system and wherein the pool includes at least one applicant who is qualified to perform the at least one type of atomic unit of work;
- selecting at least one candidate from within the pool to perform the at least one type of atomic unit of work;
- negotiating a payment for each atomic unit of work with the at least one selected candidate; and
- paying each selected candidate the negotiated payment for each atomic unit of work performed.

17. (Previously Presented) The method of claim 16, wherein the pool of applicants is limited to those having a set of predetermined credentials.

18. (Previously Presented) The method of claim 16 further comprising the step of determining the pool of potential candidates via an indirect message delivery process.

19. (Previously Presented) A method for efficiently performing a task, the method comprising the steps of:

- separating the task into subparts, wherein certain of the subparts may be performed on an atomic unit basis by a pool of potential workers;
- determining the type of atomic units of work needed to perform the subparts of the task that may be performed on an atomic unit basis;
- selecting at least one candidate to perform each type of atomic unit of work;
- receiving the work product for each performed atomic unit of work over the Internet at an employer computer system; and
- paying each selected candidate for each received atomic unit of work on a predetermined basis.

20. (Withdrawn) An administrative system for employing workers in a distributed environment comprising:

- a knowledge-base of information as to potential workers;
- a communication subsystem that communicates via a trusted computing environment with potential employers and potential workers, neither of which operate the administrative system;
- a selection subsystem that selects a pool of potential workers based on input provided by an actual employer;
- a reporter subsystem that provides to the actual employer a list of the selected pool of applicants;
- a tracking subsystem that tracks the atomic units of work performed by workers chosen by the actual employer to perform select atomic units of work; and
- a payment subsystem that pays workers for performed select atomic units of work by drawing off an electronic account that is funded by the actual employer but accessible to the payment subsystem.

21. (Previously Presented) A method for efficiently utilizing the skills of individual independent contractors, whose individual skills have been input as searchable data in an electronic database, the method comprising the steps of:

searching the database to identify a group of individual independent contractors whose skills, as indicated by the data in the database, match criteria necessary to complete a type of atomic unit of work;

offering to the individual independent contractors in the identified group an opportunity to perform the type of atomic units of work;

selecting at least one individual independent contractor from the group to perform the type of atomic units of work;

providing the selected individual independent contractor with uncompleted atomic units of work;

receiving the work product for each completed atomic unit of work from the selected individual independent contractor over the Internet at an employer computer system; and

paying the selected individual independent contractor for each completed atomic unit of work.

22. (Previously Presented) The method of claim 21, wherein a type of atomic unit of work is reviewing a document of predetermined length for typographical errors.

23. (Previously Presented) The method of claim 21, wherein a type of atomic unit of work is transcribing dictation of a predetermined duration.

24. (Previously Presented) The method of claim 23, wherein the predetermined duration is ten minutes.

25. (Previously Presented) The method of claim 21, wherein a type of atomic unit of work is verifying data relating to an insurance claim.

26. (Previously Presented) The method of claim 25, wherein data relating to an insurance claim includes a description of the events leading to the claim.

27. (Previously Presented) The method of claim 21, wherein an atomic unit of work is processing an invoice in an accounts payable file.

28. (Previously Presented) The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes the ability to read the English language.

29. (Previously Presented) The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes a high school diploma.

30. (Previously Presented) The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes a certification of completion of specialized training pertaining to the type of atomic unit of work.

31. (Previously Presented) The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes a predetermined level of prior experience in conducting the type of atomic unit of work.

32. (Previously Presented) The method of claim 31, wherein the predetermined level of prior experience is the prior completion of 100 atomic units of work of the type of atomic unit of work.

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Evidence Appendix

NONE

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Related Proceedings Appendix

NONE